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MAR 21 2005
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PTO/SB/64 (09-04)
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PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

Docket Number (Optional): NPA005US

First named inventor: Kia Silverbrook

Application No.: 09/575,132 Art Unit: 3622

Filed: May 23, 2000 Examiner: Kanh H. Le

Title: Method and system for providing targeted information in a document

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX (703) 872-9306

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee;
(2) Reply and/or issue fee;
(3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
(4) Statement that the entire delay was unintentional.

1.Petition fee

☐ Small entity-fee $ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☑ Other than small entity – fee $ 1,500.00 (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of Response + RCE (identify type of reply):

☐ has been filed previously on _____.
☑ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of $ _____.

☐ has been paid previously on _____.
☐ is enclosed herewith.

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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02 FC:1453 1500.00 OP

3. Terminal disclaimer with disclaimer fee

☑ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of $ _____ for a small entity or $ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

_____ Signature	March 16, 2005 Date
Kia Silverbrook and Paul Lapstun Typed or printed name	_____ Registration Number, if applicable
393 Darling Street Balmain, NSW, Australia Address	+61298186633 Telephone Number
_____ Address	

Enclosures:
☑ Fee Payment
☑ Reply
☐ Terminal Disclaimer Form
☑ Additional sheets containing statements establishing unintentional delay
☑ Other: RCE

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☐ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office as (703) 872-9306.

_____ Date	_____ Signature
	_____ Typed or printed name of person signing certificate

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MAR 21 2005
PATENT & TRADEMARK OFFICE

Attachment to:
Form PTO/SB/64 (08-03)

USSN 09/575,132

STATEMENT OF UNINTENTIONAL DELAY

The Applicant respectfully submits that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137 (b) was unintentional.

The Applicant submits that, after the faxed response dated September 20, 2004 was sent to the USPTO, the Applicant intended to enter a deadline in its database to monitor the due date, the six months past the Final Office Action, by which a Request for Continued Examination (RCE) would have been immediately faxed to the USPTO to maintain the application alive. Unfortunately, due to a clerical error, the deadline was not entered into the database. The Applicant respectfully submits that he had every intention of continuing with the prosecution of the application.

The Applicant now submits the RCE and respectfully requests that the petition to reinstate the prosecution of this application be granted.

A check is attached to cover the petition, and the RCE, amounting to $2,290.00.

.....
Kia Silverbrook

March 16, 2005

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MAR 21 2005
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DAC

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Request for Continued Examination (RCE) Transmittal

Address to:
Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Application Number	09/575,132
Filing Date	May 23, 2000
First Named Inventor	Kia Silverbrook
Art Unit	3622
Examiner Name	Khanh H. Le
Attorney Docket Number	NPA005US

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.
Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. Submission required under 37 CFR 1.114 Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

   a. ☐ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.

      i. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____

      ii. ☐ Other _____

   b. ☑ Enclosed

      i. ☑ Amendment/Reply

      ii. ☐ Affidavit(s)/ Declaration(s)

      iii. ☐ Information Disclosure Statement (IDS)

      iv. ☑ Other Petition for Revival

2. Miscellaneous

   a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)

   b. ☐ Other _____

3. Fees The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.

   a. ☐ The Director is hereby authorized to charge the following fees, or credit any overpayments, to Deposit Account No. _____. I have enclosed a duplicate copy of this sheet.

      i. ☐ RCE fee required under 37 CFR 1.17(e)

      ii. ☐ Extension of time fee (37 CFR 1.136 and 1.17)

      iii. ☐ Other _____

   b. ☑ Check in the amount of $ _____ enclosed

   c. ☐ Payment by credit card (Form PTO-2038 enclosed)

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Signature		Date	March 16, 2005
Name (Print/Type)	Kia Silverbrook and Paul Lapstun	Registration No.	

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

Signature			
Name (Print/Type)	Kia Silverbrook and Paul Lapstun	Date	March 16, 2005

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**
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03/22/2005 EABUBAK1 00000039 09575132
01 FC:1801 790.00 OP

MAR 21 2005
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In the United States Patent and Trademark Office

Serial Number:	09/575,132
Application. Filed:	May 23, 2000
Applicant:	Kia Silverbrook and Paul Lapstun
Application. Title:	Method and system for providing targeted information in a document
Examiner/GAU:	Khanh H. Le/3622
Dated	March 17, 2005
At:	Balmain, NSW
Docket No.	NPA05US

AMENDMENT C

Commissioner for Patents
Washington, District of Columbia 20231

Dear Sir:

In response to the Advisory Action of November 12, 2004, please amend the above-identified application as follows:

Amendments to the Specification begin on page 2 of this paper. The Applicant submits that these amendments introduce no new matter.

Amendments to the Claims begin on page 3 of this paper. The Applicant submits that these amendments introduce no new matter.

Remarks/Arguments begin on page 7 of this paper.

Amendments to the Specification:

The paragraph beginning at Page 1, lines 14-32, to be amended as follows:

Various methods, systems and apparatus relating to the present invention are disclosed in the following co-pending applications filed by the applicant or assignee of the present invention on 23 May 2000:

09/575,197 09/575,195, 09/575,159, 09/575,132, 09/575,123,
09/575,148, 09/575,130, 09/575,165, 09/575,153, 09/575,118,
09/575,131, 09/575,116, 09/575,144, 09/575,139, 09/575,186,
09/575,185, 09/575,191, 09/575,145, 09/575,192, ~~09/609,303,~~
~~09/610,095,~~ ~~09/609,596,~~ 09/575,181, 09/575,193, 09/575,156,
09/575,183, 09/575,160, 09/575,150, 09/575,169, 09/575,184,
6,502,614, 09/575,180 09/575,149, 6,549,935, 09/575,187,
09/575,155 6,591,884, 6,439,706, 09/575,196, 09/575,198,
09/575178, 6,428,155, 09/575,146, ~~09/608,920,~~ 09/575,174,
09/575,163, 09/575,168, 09/575,154, 09/575,129, 09/575,124,
09/575,188, 09/575,189, 09/575,162, 09/575,172, 09/575,170,
09/575,171, 09/575,161, 10/291,716 , 6,428,133, 6,527,365,
6,315,399, 6,338,548, 6,540,319, 6,328,431, 6,328,425,
09/575,127, 6,383,833, 6,464,332, 6,390,591, 09/575,152,
6,328,417, 6,409,323, 6,281,912, 6,604,810, 09/575,112,
6,488,422, 09/575,108, 09/575,109.

Amendments to the Claims:
This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

1. (Currently Amended) A method for providing targeted content in a document, the method including, in a printer:

~~providing a user with~~ receiving from a computer system of a publication server, information for generation of a printed document, the information being formatted by the computer system according to stored user preferences to include ~~information with~~ content targeted to demographics of the user~~.~~; and,

printing the document ~~having~~ with at least one user interactive element which enables the user to indicate a request for further information relating to the content by interacting with the element using a sensing device which is adapted to transmit data indicating the request to a computer system.

2. (Original) A method as claimed in claim 1, further including sending the further information to the user upon receipt of the data in the computer system.

3. (Cancelled).

4. (Original) A method as claimed in claim 1, wherein the targeted content comprises advertising material.

5. (Original) A method as claimed in claim 4, wherein the at least one interactive element is provided in association with the advertising material and the further information is provided in the form of a printed product brochure.

6. (Original) A method as claimed claim 1, wherein the document includes coded data indicative of an identity of the document and of the at least one interactive element, and wherein the method includes receiving, in the computer system, indicating data from the sensing device regarding the identity of the document and a position of the sensing device relative to the document in order to identify the document and determine when the sensing device is used to interact with the element.

7. (Original) A method as claimed in claim 6, including receiving, in the computer system, movement data regarding movement of the sensing device relative to the document.

8. (Original) A method as claimed in claim 7, including the sensing device sensing its movement relative to the document using at least some of the coded data, and identifying the request in the computer system from the movement being at least partially within a zone associated with the interactive element.

9. (Original) A method as claimed in claim 1, wherein the sensing device includes an identification code specific to a particular user and the method includes monitoring use of the sensing device in the computer system.

10. (Previously Presented) A method as claimed in claim 6, including printing the document on a surface of a surface-defining structure, and at the same time, printing the coded data on the surface.

11. (Original) A method as claimed in claim 6 which includes printing the coded data to be substantially invisible in the visible spectrum.

12. (Original) A method as claimed in claim 6, including retaining a retrievable record of the printed document, the document being retrievable using the identity data as contained in the coded data.

13. (Original) A method as claimed in claim 6, in which the document is printed on multiple pages and in which the method includes binding the pages.

14. (Previously Presented) A system for providing targeted content in a document, including:

a computer system of a publication server adapted to format information in accordance with stored user preferences for generation of a printed document, the information including content targeted to demographics of the user;

a printer for receiving the information from the publication server and printing the document with at least one interactive element to enable a user to indicate a request for further information related to the content; and

a sensing device used to indicate the request and adapted to transmit request data to the computer system.

15. (Original) The system as claimed in claim 14, wherein the publication server is adapted to include at least a portion of the content as advertising material.

16. (Original) A system as claimed in claim 15, wherein the advertising material is included with reference to user content preferences.

17. (Original) A system as claimed in claim 14, further including an advertising server for providing the advertising material to the publication server.

18. (Original) A system as claimed in claim 14, further including a registration server where demographic data of the user is stored for access by the publication server, in order to allow the advertising material to be demographically targeted.

19. (Original) A system as claimed in claim 14, wherein the document includes coded data indicative of an identity of the document and of the at least one interactive element.

20. (Original) A system as claimed in claim 19, wherein the computer system is adapted to receive movement data regarding movement of the sensing device relative to the document, and interpret said movement of the sensing device as it relates to said at least one element.

21. (Original) A system as claimed in claim 20, wherein the sensing device senses its own movement relative to the document using the coded data.

22. (Original) A system as claimed in claim 14, wherein the sensing device includes an identification code specific to a particular user and the computer system is arranged to monitor the use of the sensing device.

23. (Original) A system as claimed in claim 14, wherein the sensing device includes a marking nib.

24. (Original) A system as claimed in claim 14, wherein the document is printed on a surface of a surface-defining structure and wherein the printer prints the document on demand.

25. (Original) A system as claimed in claim 19, wherein the printer is arranged to print the coded data at the same time as printing the document on a surface-defining structure.

26. (Original) A system as claimed in claim 19, wherein the coded data is substantially invisible in the visible spectrum.

27. (Original) The system as claimed in claim 19, including a database for keeping a retrievable record of each document generated, each document being retrievable by using its identity, as included in its coded data.

28. (Original) The system as claimed in claim 14, wherein the printer includes a binding means for binding the document in the event the document includes a plurality of pages.

REMARKS/ARGUMENTS

The Office Action has been carefully considered. The issues raised are traversed and addressed below with reference to the relevant headings and paragraph numbers appearing under the Detailed Action of the Office Action.

Claim Rejections – 35 U.S.C. §103

The Examiner has maintained objections to the claims on the basis of the cited "Intelligent Paper" reference.

We respectfully reiterate our previous comments that we do not believe it would be obvious to combine the teaching of this document with knowledge of demographic targeted marketing to teach the requirement of the claims. In particular, there is nothing within the "Intelligent Paper" reference to suggest that it can have a use to provide printed documents that are formatted in accordance with stored user preferences.

In this regard, we note that the Examiner has drawn our attention to page 401 as indicating that the user's address is known and stored on a system. However, this does not describe that documents are formatted in accordance with the user preferences, and in fact there is nothing within the teaching of this document to suggest that printed documents would be in anything other than a standard predetermined format.

In this regard, the Examiner has asserted that as the intelligent paper could be used as a web-page, then this renders it obvious that the demographic information may be used for formatting. We respectfully submit that this is not the case. When web-pages are displayed as electronic documents, the provision of Hyper-text Mark-up Language, allows the appearance of the page to be configured for use on the respective display device. Interactivity is then feasible as the electronic device is able to interpret input commands, using standard input devices.

However, in the case of intelligent paper, formatting the document and ensuring that selection of a user interactive element may be achieved is more complex as the detection of a selection must be performed remotely. As this requires interpretation of signals from the

sensing device, this becomes a more complex procedure, and there is no disclosure in the "Intelligent Paper" reference of how responsiveness for individual user tailored documents could be achieved.

If a document is formatted differently due to different user preferences, the position of the user interactive element may vary between versions of the document. For example, if two users print the same document but specify different font sizes in their user preferences, then the spacing of text within the document would be different in both cases. As a result, a user interactive element positioned after the text would be in a different position in the two documents. In contrast, as the coded data is pre-printed, the position of the coded data is fixed.

The result of this is that when each user selects the user interactive element on the respective document, the signal generated by the sensing device will represent a different page location. However, the "Intelligent Paper" reference does not teach any mechanism by which this could be resolved, and therefore does not allow for the formatting of a document to vary from user to user depending on respective preferences.

Instead, the "Intelligent Paper" reference merely teaches that the system may detect ownership by an individual of a respective document. However, as will be appreciated by the Examiner, this merely requires knowledge that a document having a respective *page-id* is owned by a respective individual, and does not distinguish between the formatting of the documents.

In contrast, the present invention utilises publication servers to format the document based on user preferences. The format used can then be stored as a page description allowing the position of user interactive elements to be retrieved for that specific document.

The use of such publication servers is not disclosed in the "Intelligent Paper" reference and is not obvious based on demographic marketing information.

Thus we do not believe a combination of the "Intelligent Paper" reference and knowledge of demographic marketing renders the claims obvious.

In any event, we also submit that there are additional distinctions in the claims which are not disclosed by such a combination.

In this regard, we note that the Examiner has specified in previous Office Actions that claim 14 includes substantially parallel limitations to claim 1, and we respectfully submit that this is not the case. In particular, we believe that claim 14 highlights some further major distinctions over the "Intelligent Paper" reference. Accordingly, in order to obtain speedy allowance of the case and to overcome the Examiner's outstanding objections claim 1 has been amended to correspond to independent claim 14.

In particular, whilst claim 1 was previously only limited to providing a printed document, claim 14 explicitly includes reference to requirements for both a publication server, and a printer for printing information received from the publication server. We respectfully submit that this is not taught or even remotely suggested by the "Intelligent Paper" reference.

In this regard, as clearly set out on pages 8 and 9 of our previous response, the claimed system utilises an advantageous system arrangement in which a publication server is used to provide content formatted according to a reader's explicitly stated and implicitly captured profile.

The system operates by allowing the publication server to dynamically assess the information that is to be printed and then format this information in the appropriate manner. The formatted information is then provided to a printer that then prints a document with at least one interactive element. The provision of a printer, which receives information from a publication server and then prints a formatted document with an interactive element is not shown in the "Intelligent Paper" reference.

In this regard, as clearly set out on the first paragraph page 394 of the cited reference, the "Intelligent Paper" system works by having an authorised producer produce sheets of paper which include encoded data. A publisher then uses the apparently blank sheets to print information with conventional visible inks.

Thus, the publisher only prints information on the sheet, and does not print the document with a user interactive element.

In contrast to this, the system of the current application operates to print not only information formatted in accordance with stored user preferences but also the at least one interactive element, which as the Examiner will appreciate is embodied in one example by netpage tags.

We respect that we submit that this distinction was previously clearly embodied in claim 14 which requires the presence of a printer for printing the document with at least one interactive element. This is clearly not taught or suggested by the "Intelligent Paper" reference.

Instead, the "Intelligent Paper" reference requires the presence of a first printer for printing the sheets including the coded data (which embodies the user interactive element) and a second printer for printing the visible information thereon. This mechanism does not allow the coded data to reflect the visible information printed on the page. This represents a substantial disadvantage over the system of the present invention.

In particular, the system defined by claim 14 allows a printer to be provided at the so-called point of consumption (ie, the printer can be provided in a user's home or the like). This is clearly discussed on page 10, lines 19 to 28 of the specification as filed.

In contrast to this, in the system of the "Intelligent Paper" reference such an arrangement is not possible as the paper must be pre-printed with coded data and then subsequently and separately printed with the visible information. As a result, this will not allow the "Intelligent Paper" system to automatically and dynamically format the information as set out in the claims.

Thus, the "Intelligent Paper" reference, as it uses pre-printed substrates, provides no mechanism for determining a concordance between the coded data provided on the substrate and the desired position of user interactive elements, which as will be appreciated by the Examiner, may vary in position dependent on the formatting of the information presented thereon, and will therefore in turn depend on the user preferences.

It is also apparent from this, that the system of the "Intelligent Paper" reference suffers from disadvantages in accuracy. In particular, when visible information is printed onto the pre-coded substrate, it is vital that the information be printed at the intended location so that it corresponds to the intended coded data. If the paper is skewed during printing for example, the position of the visible information will not be as intended, and accordingly, the designation of the user interactive element will not function correctly.

In contrast, in the current system, the positioning of the user interactive element, and the coded data that embodies the element, can be controlled dynamically at the time the formatting is performed by the publication server. This information can then be transferred electronically to the printer, thereby ensuring that the user interactive element can be correctly provided on the respective page. Furthermore as the visible information is printed at the same time, concordance between the visible information and the user interactive element will always be ensured.

The fact that the dynamic and responsive operation of the system allow the information to be formatted and printed on demand (ie, at the time a request is made by a user) makes the system ideally suited for providing content targeted to demographics of the user based on stored user preferences. In particular, this allows the formatted information to incorporate the user interactive element in a manner that is not feasible with the system of the prior art.

In this regard, we note that the Examiner has acknowledged that Dymetman can provide product catalogues that are formatted with the user's address to allow a catalogue to be transferred by standard mail. This highlights that the system requires pre-printing and subsequent mailing of the information and does not allow the documents to be printed at their point of consumption.

Thus, the arrangement of the claims in which a printer receives formatted information from a publication server and then uses the formatted information to print a document and a user interactive element is not taught or even suggested by the "Intelligent Paper" reference.

Furthermore, we would submit that it is not even possible to use the "Intelligent Paper" system in the manner taught by claim 1 due to the inherent limitation in having the coded substrate printed during a separate step.

In view of this, we respectfully submit that the claims are novel and inventive.

CONCLUSION

In light of the above, it is respectfully submitted that the objections and claim rejections have been successfully traversed and addressed. The amendments do not involve adding any information that was not already disclosed in the specification, and therefore no new matter is added. Accordingly, it is respectfully submitted that the claims 1 to 28, and the application as a whole with these claims, are allowable, and a favourable reconsideration is therefore earnestly solicited.

Very respectfully,

Applicant:

TOBIN ALLEN KING

Applicant:

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